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Date 3/1/06 Patrick R. Turner

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Frederick R. Peterson
Application No. : 10/796,410
Filed : March 9, 2004
For : METHOD AND SYSTEM FOR STORING AND DISPENSING
ROLLED PAPER PRODUCTS

Examiner : Gary E. Elkins
Art Unit : 3727
Docket No. : 35032.001
Date : March 1, 2006

COMMISSIONER FOR PATENTS
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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Restriction Requirement dated February 3, 2006, Applicant hereby provisionally elects, with traverse, Group I, claims 1-6. However, as noted in the previous sentence, Applicant respectfully traverses the restriction requirement.

First, Applicant's representative fails to understand the Examiner's determination that the dispenser of claims 1-6 can be used for extracting any number of products, such as batteries and cans, while the method claims 7-11 are limited to extracting horizontally-positioned rolls of paper products.

According to MPEP § 806.05(h):

A product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process.

The burden is on the examiner to provide an example, but he example need not be documented.

If the applicant either proves or provides a convincing argument that the alternative cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement. (emphasis added)

Applicant's representative believes that claims 1-6 claim a product and claims 7-11 claim a process of using the product claimed in claims 1-6. Independent claim 1 clearly identifies the dispenser at issue as a rolled-paper-product dispenser into which rolled-paper products can be stacked. Independent claim 1 claims:

1. **A rolled-paper-product dispenser** having an openable top and a bottom proximal to a dispensing aperture comprising:
 - a vertical back piece;
 - two vertical side pieces connected to the vertical back piece;
 - a vertical front piece, including the dispensing aperture, connected to the two vertical side pieces;
 - a top flap connected to one of the vertical pieces that fastens to another of the vertical pieces to enclose the top of the rolled-paper-product dispenser; and
 - a bottom flap that fastens to one of the vertical pieces to enclose the bottom of the rolled-paper-product dispenser in order to support **a number of rolled-paper products stacked within the rolled-paper-product dispenser** for storage and for subsequent manual removal through the dispensing aperture, unfastening of the top flap and bottom flap allowing the rolled-paper-product dispenser to fold flat for storage, shipping and retail distribution. (emphasis added)

Because the preamble of claim 1 describes the device as a rolled-paper-product dispenser, and the final element of independent claim 1 specifically mentions the stacking of a number of rolled-paper products within the rolled-paper-products dispenser, it should be clear that independent claim 1 specifically claims being used for rolled-paper products and does not support the broad interpretation suggested by Examiner.

Second, according to MPEP § 803:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – 806.04(i)) or distinct (MPEP § 806.05 – 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (emphasis added)

The method claims of the current application specifically recite use of the rolled paper product dispenser claimed in claim 1 for storing and dispensing rolled-paper products. Thus, it is difficult to imagine any serious burden associated with searching for references related both to the rolled-paper-product dispenser claims and to the method claims that claim a method for storing and dispensing rolled-paper products. In Applicants' representative's opinion, it would, in fact, be a far more serious burden to independently search and examine

the closely related claim sets identified by the Examiner, than to search and examine them together. Applicant's representative notes that many thousands of patents have issued with both system and method claims.

In view of the above election, Applicant requests that claims 7-11 be cancelled without prejudice to the filing of any divisional, continuation, or continuation-in-part application. Consideration of the elected claims is now requested.

Respectfully submitted,

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